



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/552,313

09/11/2006

Tobias Schweiger

298-303

8267

7590
Dilworth & Barrese
333 Earle Ovington Blvd.
Suite 702
Uniondale, NY 11553

09/01/2009

EXAMINER

DONADO, FRANK E

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

09/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,313	Applicant(s) SCHWEIGER ET AL.	
	Examiner FRANK DONADO	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/6/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,22-26,28,30,33,34 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,22-26,28,30,33,34 and 37 is/are rejected.
- 7) ☒ Claim(s) 1 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/6/09 has been entered.

Response to Amendment

2. The amendment filed on 8/6/09 has been entered. Claims 1-2, 4, 8, 10-18, 22-26, 28, 30, 33-34 and 37 have been amended. Claims 21, 27, 31-32 and 35-36 have been cancelled. Claim 37 has been added. Claims 1-20, 22-26, 28, 30, 33-34 and 37 are currently pending in this application, with claims 1, 33 and 37 being independent.

Claim Objections

3. Claim 1 is objected to because of the following informalities: “**...distinct from into the mobile device...**” should be changed to “**...distinct from the mobile device...**”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2617

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-17, 19-20, 22-25, 28, 30 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant, et al (**US Patent No. 5,802,468**), in view of Harvinis, et al (**US PG Publication 6,216,007**). From now on, Gallant, et al, will be referred to as Gallant, and Harvinis, et al, will be referred to as Harvinis.

Regarding claim 1, Gallant teaches a communications system for mobile radio telephony, the system comprising: a plurality of mobile devices operable within a total

Art Unit: 2617

territory of the communication system (**Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67**), the total territory being divided into a plurality of location areas (**Said communication system is divided into a plurality of cells that define the current location of said mobile stations, Column 2, lines 32-39**), each mobile device comprising a module insertable into, removable from and distinct from the mobile device (**A Subscriber Identification Module (SIM) is inserted into said mobile station, Column 7, lines 32-37**), each mobile device being associated with at least one subscriber territory being fixed inside the total territory (**An identification code in said SIM defines the home geographic location for said mobile station used to define a home calling area, Column 7, lines 32-46**), wherein the at least one subscriber territory includes at least a portion of at least one location area from among the plurality of location areas and wherein a processor coupled to the module is configured to determine whether a respective mobile device is located inside the at least one subscriber territory (**Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31**). Gallant does not teach the location determination is performed by an application within the SIM. Harvinis teaches teach the location determination is performed by an application within the SIM (**A location calculation module (LCM) resides within a smart IC card that is a SIM card for determining the location of a mobile terminal, Column 3, lines 9-26 and**

Art Unit: 2617

Column 5, lines 21-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature for the benefit of transmission efficiency and service variety. Additionally, since the module of Harvinis stores BTS identifiers and performs the location calculation, and since it is known in the art to perform a comparison of identifiers in the manner described by the limitations of the claims above using the techniques employed by Gallant, it would have been obvious to one of ordinary skill in the art at the time of the invention to locate the processor within the SIM instead of coupling it to the SIM to provide this feature, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding claim 2, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 1. Harvinis further teaches the module is the subscriber identification module (**Column 3, lines 9-26 and Column 5, lines 21-24**).

Regarding claim 3, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 1. Gallant further teaches location areas in which one or more radio cells are located are arranged in the total territory covered by the communications system (**Said home calling areas that overlap with cells lie within said communication system, Column 7, lines 42-46**).

Art Unit: 2617

Regarding claim 4, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 3. Gallant further teaches location areas and/or the radio cells have identity data characterizing them **(Said home calling areas are associated with assigned BTS identifiers, Column 10, lines 11-19).**

Regarding claim 5, Gallant, in view of Harvinis teaches a communications system in accordance with claim 4. Gallant further teaches the identity data include identifiers and coordinates **(Said home calling areas are associated with assigned BTS identifiers and their corresponding coordinates, Column 10, lines 11-19).**

Regarding claim 6, Gallant, in view of Harvinis teaches a communications system in accordance with claim 4. Gallant further teaches the system comprising means for transmitting the identity data of the location areas and/or of the radio cells to the mobile devices **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells, Column 10, lines 19-21 and Column 7, lines 54-55).**

Regarding claim 7, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Gallant further teaches an interface is provided in the mobile devices by means of which the identity data can be transmitted to the module **(Cell identifier information is transmitted to the mobile unit, Column 10, lines 19-21 and Column 7, lines 54-55).**

Regarding claim 8, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Gallant further teaches means are provided in said processor coupled to the module by means of which the identity data of the location area or radio cell in which the mobile device is located can be compared with data characterizing the subscriber territory **(Said assigned BTS identifiers defining coordinates of the home calling area are compared with BTS identifiers of said mobile station's current location during a registration process of said mobile station, Column 10, lines 19-31)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 9, Gallant, in view of Harvinis teaches a communications system in accordance with claim 8. Gallant further teaches the data characterizing the subscriber territory include identifiers and coordinates of the locations areas and/or radio cells located in the subscriber territory **(Said assigned BTS identifiers define coordinates of the home calling area, Column 10, lines 19-31)**.

Regarding claim 10, Gallant, in view of Harvinis teaches a communications system in accordance with claim 8. Gallant further teaches the data characterizing the

Art Unit: 2617

subscriber territory are stored in the module **(Said identification code that defines home calling area information is stored in said SIM, Column 7, lines 32-46).**

Regarding claim 11, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Harvinis further teaches the module is effective to determine whether the coordinates of a location area or of a radio cell of the communications system are disposed in a region which is fixed by a location **(Coordinates of said mobile subscriber are determined by said SIM to define said location, Column 4, lines 62-67 and Column 5, lines 1-4).** Gallant further teaches the radius of a circle surrounding the location as a center **(Said home calling area is defined by a circular area with a radius, where said home calling area and its associated coordinates are used to determine whether mobile device is located inside home location, Column 7, lines 46-49, Column 10, lines 16-18 and Column 10, lines 25-28).**

Regarding claim 12, Gallant, in view of Harvinis teaches a communications system in accordance with claim 11. Gallant further teaches the coordinates of the location and the radius are stored in the module **(Said coordinates of said geographical address of said mobile station used to define said radius are stored in said SIM, Column 10, lines 16-18 and Column 7, lines 42-49).**

Art Unit: 2617

Regarding claim 13, Gallant, in view of Harvinis teaches a communications system in accordance with claim 11. Gallant further teaches the identifiers of the location areas and/or of the radio cells identify the corresponding coordinates of the location area and/or of the radio cell to which they apply to facilitate a determination of the coordinates from the identifiers **(Both said cell identifiers and said identification codes that define home calling areas have corresponding coordinates, Column 10, lines 12-17 and Column 3, lines 23-26).**

Regarding claim 14, Gallant, in view of Harvinis teaches a communication system in accordance with claim 13. Gallant further teaches the identifiers of the location areas and/or of the radio cells are designated such that they are in a relationship with the coordinates of the location area and/or of the radio cell so that the coordinates can be determined from the identifiers **(Both said cell identifiers and said identification codes that define home calling areas have corresponding coordinates and, as is commonly understood in the art, are uniquely different from one another, Column 10, lines 12-17 and Column 3, lines 23-26).**

Regarding claim 15, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Harvinis further teaches means are provided in the module by which the coordinates can be determined **(Said SIM LCM application determines said coordinates of mobile terminal, Column 4, lines 62-67 and Column 5, lines 1-4).** Gallant further teaches coordinates are determined on the basis

Art Unit: 2617

of the identifiers **(Coordinates are associated with said identifiers of home calling areas, Column 3, lines 23-26).**

Regarding claim 16, Gallant, in view of Harvinis teaches a communications system in accordance with claim 15. Gallant further teaches a processor coupled to the module has means by which it can be determined whether the identifier of a location area and/or of a radio cell coincides with a predetermined identifier of the location area and/or of the radio cell of the subscriber territory **(Said home calling area identification is predetermined and current cell area information is then determined from current cell ID information and compared within said processor coupled to SIM module, Column 7, lines 32-37 and Column 10, lines 19-31).**

Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24).**

Regarding claim 17, Gallant, in view of Harvinis teaches a communications system in accordance with claim 16. Gallant further teaches the predetermined identifier is stored in the module **(Said identification code that defines home calling area information is stored in said SIM, Column 7, lines 32-46).**

Regarding claim 19, Gallant, in view of Harvinis teaches a communications system in accordance with claim 1. Gallant further teaches the system further comprises an interface between the mobile device and the module to facilitate the transmission of a control signal indicating whether the mobile device is located in a subscriber territory **(The mobile unit communicates with said BTS and the determination is made as to whether the mobile unit location is within its home calling area, Column 10, lines 19-31).**

Regarding claim 20, Gallant, in view of Harvinis teaches a communication system in accordance with claim 1. Gallant further teaches the system configured to perform a method of operating a communications system for mobile radio telephony **(Calling areas are defined within a mobile communication system, where said communication system include a plurality of mobile stations operable within said communication system, Column 1, lines 7-10 and 67)**, the communication system being divided into a plurality of location areas **(Said communication system is divided into a plurality of local calling areas that are larger than home calling areas, Column 7, lines 22-24)**, each location area including at least one radio cell **(Said communication system is divided into a plurality of cells that overlap with said home calling areas that are contained within said local calling areas, indicating local calling areas contain cells, Column 7, lines 54-55 and 60-63)**, the method comprising: assigning at least one subscriber territory to a mobile device, the subscriber

Art Unit: 2617

territory being defined according to three parameters, a subscriber X-coordinate position, a subscriber Y-coordinate position and a subscriber radius R, the three parameters collectively defining a circular subscriber territory within a total territory of the communication system **(Said home geographic location that is used to define said home calling area and is defined by said identification code in said SIM includes coordinate and radius information, Column 7, lines 32-49 and Column 10, lines 16-18)**; receiving an X-coordinate position and a Y-coordinate position of one of said location areas or radio cells within the communication system at the mobile device **(Said mobile station receives and decodes coordinate identifier fields transmitted by a Base Transceiver Station (BTS) that control said cells, Column 10, lines 19-21 and Column 7, lines 54-55)**; determining whether the received X-coordinate position and the received Y-coordinate position of one of said location areas or radio cells is disposed within the subscriber territory as defined by said subscriber X-coordinate position, said subscriber Y-coordinate position and subscriber radius R **(Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31)**; and informing a subscriber of the mobile device that the subscriber is within the subscriber territory in the case where said determining step is true **(Result from said determination is sent accordingly, Column 10, lines 31-33)**.

Art Unit: 2617

Regarding claim 22, Gallant, in view of Harvinis teaches a communication system in accordance with claim 20. Gallant further teaches the examination whether the coordinates of a location area and/or of a radio cell are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center is performed by said processor coupled to the module **(Said determination occurs at SIM, Column 10, lines 19-31)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 23, Gallant, in view of Harvinis teaches a communication system in accordance with claim 1. Gallant further teaches an examination whether the identifier of a location area or of a radio cell coincides with a predetermined identifier of a location area or of a radio cell is performed by said processor coupled to the module **(Comparisons of said cell identifiers and said identifiers of home calling areas take place at the SIM, Column 10, lines 19-31)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 24, Gallant, in view of Harvinis teaches a communication system in accordance with claim 22. Gallant further teaches said examination whether the identifier of a location area or radio cell coincides with a predetermined identifier takes place prior to the examination whether the coordinates of a location area and/or of a radio cell are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center is performed by said processor coupled to the module **(The identifiers are decoded before a radius distance values is calculated, Column 10, lines 19-28)**. Harvinis further teaches means are provided in the module for receiving coordinate data of the location area and determining the location of said mobile device based on said coordinate data **(Received BTS coordinates are used by said SIM LCM application to determine said location of mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24)**.

Regarding claim 25, Gallant, in view of Harvinis teaches a communication system in accordance with claim 20. Gallant further teaches the location and the radius of the region and/or the predetermined identifiers are stored in the module **(Said predetermined identifiers of home calling areas are stored in said SIM, Column 7, lines 32-37 and 42-46)**.

Art Unit: 2617

Regarding claim 28, Gallant, in view of Harvinis teaches a communication system in accordance with claim 20. Gallant further teaches the identifier of the location area and/or of the radio cell and/or their coordinates are forwarded by a transmitter and receiver station to the module within the mobile device. **(Said BTS transmits coordinate information to said SIM, Column 10, lines 19-21).**

Regarding claim 30, Gallant, in view of Harvinis teaches the communication system according to claim 20. Gallant further teaches the assigning step further comprises storing the three parameters within a memory of the mobile device **(Said coordinates are stored in said SIM, Column 10, lines 16-18).**

Regarding claim 33, Gallant teaches a method of operating a communications system for mobile radio telephony, the communication system being divided into a plurality of location areas **(A communication system is divided into a plurality of local calling areas that are larger than home calling areas, Column 7, lines 22-24),** each location area including at least one radio cell **(Said communication system is divided into a plurality of cells that overlap with said home calling areas that are contained within said local calling areas, indicating local calling areas contain cells, Column 7, lines 54-55 and 60-63),** the method comprising: assigning at least one first identifier to a mobile device defining at least one subscriber territory of the mobile device **(Said home calling areas are associated with assigned BTS identifiers, Column 10, lines 11-19);** receiving, at the mobile device, a second

Art Unit: 2617

identifier of one of a location area or a radio cell within the communication system

(Current areas in which said mobile station is located are associated with BTS identifiers of said mobile station's current location, Column 10, lines 19-31);

determining, using a processor coupled to the module insertable into, removable from,

and distinct from the mobile device, whether the first identifier matches the second

identifier **(Comparisons of said cell identifiers and said identifiers of home calling**

areas take place, Column 10, lines 19-31); and informing a subscriber of the mobile

device that the subscriber is within the subscriber territory when the first identifier

matches the second identifier **(Result from said determination is sent accordingly,**

Column 10, lines 31-33). Gallant does not teach the location determination is

performed by an application within the SIM. Harvinis teaches teach the location

determination is performed by an application within the SIM **(A location calculation**

module (LCM) resides within a smart IC card that is a SIM card for determining

the location of a mobile terminal, Column 3, lines 9-26 and Column 5, lines 21-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the invention of Gallant to include this feature for the benefit of transmission

efficiency and service variety. Additionally, since the module of Harvinis stores BTS

identifiers and performs the location calculation, and since it is known in the art to

perform a comparison of identifiers in the manner described by the limitations of the

claims above using the techniques employed by Gallant, it would have been obvious to

one of ordinary skill in the art at the time of the invention to locate the processor within

the SIM instead of coupling it to the SIM to provide this feature, since it has been held

Art Unit: 2617

that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding claim 34, Gallant, in view of Harvinis teaches the method according to claim 33. Gallant further teaches the assigning step further comprises storing the predetermined identifier within the module of the mobile device **(Said predetermined identifiers of home calling areas are stored in said SIM, Column 7, lines 32-37 and 42-46).**

8. Claims 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant, in view of Harvinis, and further in view of Olds **(US Patent No. 5,905,957).**

Regarding claim 18, Gallant, in view of Harvinis, teaches a communications system in accordance with claim 1. Gallant, in view of Harvinis, does not teach the identifiers stored in the module are at least partly stored in a form reducing the storage requirements. Olds teaches the identifiers stored in the module are at least partly stored in a form reducing the storage requirements **(The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55).** It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant,

Art Unit: 2617

in view of Harvinis to include this feature in the Subscriber Identity Module for the benefit of cost savings.

Regarding claim 26, Gallant, in view of Harvinis, teaches a method in accordance with claim 25. Gallant, in view of Harvinis does not teach the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module. Olds teaches the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module **(The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant, in view of Harvinis to include this feature in the Subscriber Identity Module for the benefit of cost savings.

9. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant, in view of Spriestersbach, et al **(US PG Publication 2003/0148775)**. From now on, Spriestersbach, et al, will be referred to as Spriestersbach.

Regarding claim 37, Gallant teaches a communications system for mobile radio telephony the system comprising: a plurality of mobile devices operable within a total territory of the communication system **(Calling areas are defined within a mobile communication system, where said communication system include a plurality of**

Art Unit: 2617

mobile stations operable within said communication system, Column 1, lines 7-10 and 67), the total territory being divided into a plurality of location areas (Said communication system is divided into a plurality of cells that define the current location of said mobile stations, Column 2, lines 32-39), each mobile device comprising a module insertable into, removable from and distinct from the mobile device (A Subscriber Identification Module (SIM) is inserted into said mobile station, Column 7, lines 32-37), each mobile device being associated with at least one subscriber territory being fixed inside the total territory (An identification code in said SIM defines the home geographic location for said mobile station used to define a home calling area, Column 7, lines 32-46 wherein the at least one subscriber territory includes at least a portion of at least one location area from among the plurality of location areas (Said home calling area overlaps said cells, and said mobile station uses SIM information to determine its location with respect to its home calling area, Column 7, lines 54-55 and Column 10, lines 19-31). Gallant does not teach each module is configured to poll a determination unit external from the mobile device to determine whether a respective mobile device is located inside the at least one subscriber territory. Spriestersbach teaches each module is configured to poll a determination unit external from the mobile device to determine whether a respective mobile device is located inside the at least one subscriber territory **(An application server 804 interacts with an application stored in a SIM based on a request from a mobile terminal 802, where after receiving mobile terminal BTS identifier information based on said request, a Geographic Information System (GIS)**

Art Unit: 2617

application 808 coupled to said application server 804 and external to said mobile terminal 802, translates BTS identifiers to mobile terminal location and transmits nearby customers to said mobile terminal 802, indicating a determination is made by said GIS application 808 as to the location of said mobile terminal relative to its nearby customers, Paragraphs 87 and 100). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gallant to include this feature for the benefit of added security.

Response to Arguments

10. Regarding the limitation that the locationing be performed by an application within the Subscriber Identity Module (SIM), said location calculation module (LCM) resides within said smart IC card that is a SIM card for determining the location of a mobile terminal, as indicated in Column 3, lines 9-26 and Column 5, lines 21-24.

Regarding the limitations that the module determine whether a respective mobile device is located inside the at least one subscriber territory and whether the identifier matches the second identifier, since the module of Harvinis stores BTS identifiers and performs the location calculation, and since it is known in the art to perform a comparison of identifiers in the manner described by the limitations of the claims above using the techniques employed by Gallant, one of ordinary skill in the art would know to locate the processor within the SIM instead of coupling it to the SIM to provide this feature.

Regarding the module polling a determination unit external from the mobile device to determine whether a respective mobile device is located inside the at least

Art Unit: 2617

one subscriber territory, an application server 804 interacts with an application stored in a SIM based on a request from a mobile terminal 802, where after receiving mobile terminal BTS identifier information based on said request, a Geographic Information System (GIS) application 808 coupled to said application server 804 and external to said mobile terminal 802, translates BTS identifiers to mobile terminal location and transmits nearby customers to said mobile terminal 802, indicating a determination is made by said GIS application 808 as to the location of said mobile terminal relative to its nearby customers, Paragraphs 87 and 100.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571) 270-5361. The examiner can normally be reached Monday-Friday, 9:30 am-6 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6361.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 2617

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-273-8300.

/Frank Donado/
Art Unit 2617

/Rafael Pérez-Gutiérrez/
Supervisory Patent Examiner, Art Unit 2617